



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,438	03/20/2000	Maryse Gibert	0660-0172-0 CONT	5905

22850 7590 04/23/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

PORTNER, VIRGINIA ALLEN

ART UNIT	PAPER NUMBER
----------	--------------

1645

DATE MAILED: 04/23/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/531,438

Applicant(s)

Gibert et al

Examiner

Portner

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Apr 10, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see attachment
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none
- Claim(s) objected to: none
- Claim(s) rejected: 42-73
- Claim(s) withdrawn from consideration: none
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Art Unit: 1645

At least for the following reasons the Amendment After Final, dated April 10, 2003, has not been entered:

a. The proposed claim amendment of claim 42, deleting the phrase "a portion thereof" (paragraph (a)), Applicant's assertion that claim 42 would not longer encompass portions, fragments or variants of SEQ ID NO 3, and claim 59 indirectly depending from claim 42 which defines the nucleic acid encoded polypeptide to include "a fragment " raises a new issue requiring additional consideration and/or search.

b. Newly proposed claims 74-79, 92-93 are drawn to a method of preparing a composition, a method not previously considered on the record, and would raise a new issue After Final requiring additional consideration and/or search.

c. Newly proposed claims 81, 83,85,87,89,91 are drawn to a purified nucleic acid that will hybridize under stringent conditions, the stringent conditions being defined as "washing at 65°C in 0.1 X SSC and 0.1% SDS"; the new combination of claim limitations not previously considered on the record raise a new issue After Final that would require additional consideration and/or search.

Art Unit: 1645

*Response to Remarks*

1. All remarks are directed to claims amendments not entered and are therefore not convincing.
2. Applicant proposes the deletion of the words “portion”, “fragment”, and “variant” and states that with the deletion of these terms from the claims the rejections under 35 U.S.C. 112, first and second paragraphs would be obviated.
3. It is the position of the examiner that this assertion is not clear in light of the newly submitted functional limitations proposed for at least claim 42. The sequence set forth in paragraph (b) of claim 42 must evidence the proposed functional limitations of a “sequence hybridizing with a complementary strand of SEQ ID NO 3 under stringent conditions, which comprise washing at 65°C in 0.1 X SSC and 0.1% SDS” ; the scope the claim raising a new issue relative to Applicant’s assertion that the claim no longer encompasses a “portion”, “fragment”, and “variant” of SEQ ID NO 3. The examiner would need to consider, if the Amendment After Final were entered, whether the new functional limitations define sequences which are portions, fragments and variants of SEQ ID NO 3, even though the claims would no longer recite these terms; the combination of newly proposed addition of claim limitations relative to the proposed deletion of claim limitations raises a new issue.
4. Amendments to the specification at pages 1, 15 and 28 would be entered if submitted separately.

Art Unit: 1645

5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (703)308-7543. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM except for the first Friday of each two week period.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this group is (703) 308-4242.

The Group and/or Art Unit location of your application in the PTO will be Group Art Unit 1645. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to this Art Unit.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Vgp

April 18, 2003

  
**LYNETTE R. F. SMITH**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**